

**REMARKS/ARGUMENTS**

By the foregoing amendments, the numbering of the claims has been corrected according to 37 C.F.R. § 1.126 to refer to each succeeding claim by a sequential number. In particular, the previous listing of the claims inadvertently included two claims numbered as "claim 31." The numbering of the claims has therefore been corrected by renumbering the second claim 31 as present claim 32. Each of the claims following present claim 32 has also been renumbered. Claims 24-40 therefore remain pending. In addition, due to the renumbering of the claims, present claims 37 and 38 have been corrected to depend from present claims 36 and 37, respectively.

Turning to the Official Action, applicants acknowledge with appreciation the Examiner's statement that the subject matter of claims 30-39 (now corresponding to claims 30-40) is allowable. For reasons explained below, however, the present claims are allowable over the cited documents. Reconsideration of the outstanding rejections is requested.

**Rejections Under 35 U.S.C. §103:**

**Claims 24-28 stand rejected under 35 U.S.C. §103(a) as being allegedly obvious over Vaeth et al. (U.S. Patent No. 5,869,135).**

Applicants respectfully traverse this rejection for at least the following reasons.

Vaeth et al. (hereinafter "Vaeth") concerns a system for selective chemical vapor deposition of polymers onto a substrate. Selective coatings and patterned layers are mentioned, including the deposition of a self-assembled patterned monolayer on the surface of a substrate (columns 3-4).

In the Official Action, it is acknowledged that "Vaeth does not disclose that the pattern is such that it comprises a first regions which corresponds to a desired surface and a second region which corresponds to the inverse of the desired surface pattern." It is nonetheless asserted that one skilled in the art would have considered it allegedly obvious to produce a particular pattern since Vaeth mentions "that a pattern may be formed on the substrate." Applicants respectfully but strongly disagree that the present claims are properly rejected on this basis.

Simply put, Vaeth does not provide the requisite information to teach or suggest the features of applicants' claims, nor any motivation that would apparently lead the skilled artisan to modify Vaeth in some manner by adding these features. As noted by the Examiner, for example, Vaeth fails to teach a "substrate having a surface with first regions that correspond to a desired surface pattern and second regions that correspond to the inverse of the desired surface pattern," as recited in claim 24. Vaeth simply does not mention anything concerning such "first regions that correspond to a desired surface pattern" in conjunction with "second regions that correspond to the inverse of the desired surface pattern." A proper *prima facie* rejection therefore does not exist absent some teaching or suggestion in Vaeth of applicants' claimed first and second regions.

Vaeth also does not provide an apparent motivation to include such first and second regions, according to applicants' claims, in a manner that might possibly suggest applicants' claims. Indeed, since Vaeth is not evidently concerned with these features, particularly applicants' claimed "second regions that correspond to the inverse of the desired surface pattern," there is no reason to consider that one skilled in the art would be led to modify Vaeth's invention to include such missing features.

As set forth in the MPEP, all the claim limitations must be taught or suggested by the prior art to establish *prima facie* obviousness of a claimed invention (see, e.g., MPEP § 2143.03, citing *In re Royka*, 490 F.2d, 981, 180 USPQ 580 (CCPA 1974)). In addition, there must be some suggestion or motivation to modify a reference or to combine teachings (see MPEP § 2143, generally). As is further discussed in the MPEP, merely because a reference or references may be modified or combined in some manner does not render the resultant combination (modification) obvious unless the prior art also suggests the desirability of the combination (see, e.g., MPEP § 2143.01, citing *In re Mills*, 916 F.2d, 680, 16 USPQ2d 1430 (Fed. Cir. 1990)). As well, the possibility that some modification is within the level of skill of the art does not, by itself, suffice to establish a *prima facie* case of obviousness without some objective reason to make the proposed modifications (see, e.g., MPEP § 2143.01, citing *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993)).

In the present case, Vaeth fails to provide a proper basis for rejection of applicants' claims since this document does not include sufficient information to establish a *prima facie* rejection. In particular, as noted above, all of the claim features are not taught or suggested by Vaeth and no motivation is provided that would evidently lead the skilled artisan to modify the invention of Vaeth to include the features of applicants' claims.

For at least the foregoing reasons, the present claims are patentable over Vaeth. Withdrawal of the rejection under §103 is requested.

**Claim 29 stands rejected under 35 U.S.C. §103(a) as being allegedly obvious over Vaeth et al. as applied to claims 24-28, and further in view of Kumar et al. (U.S. Patent No. 5,521,131).**

Applicants respectfully traverse this rejection for at least the following reasons.

Applicants' remarks concerning the rejections of claims 24-28 over Vaeth are also applicable to the rejection of claim 29 and are incorporated herein. More specifically, as discussed above, Vaeth does not teach all of the features of applicants' claims, notably a "substrate having a surface with first regions that correspond to a desired surface pattern and second regions that correspond to the inverse of the desired surface pattern."

Kumar et al (hereinafter "Kumar") fails to cure the deficiencies of Vaeth at least for the reason that there is no apparent teaching or suggestion in this secondary document to modify Vaeth by including the features of applicants' claims missing in Vaeth, *i.e.*, applicants' claimed first and second regions.

Absent some reason and motivation to modify Vaeth to include these features, applicants' claims are patentable over Vaeth, alone, and over the combination of Vaeth with Kumar.

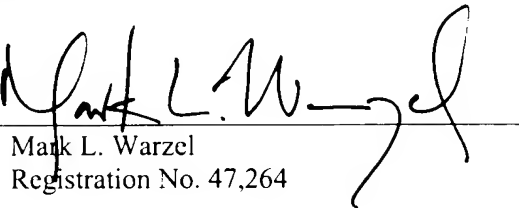
For at least the foregoing reasons, the present claims are patentable over Vaeth combined with Kumar. Withdrawal of the rejection of claim 29 under §103 is requested.

As the present claims should now be in condition for allowance, a notice to that effect is respectfully and earnestly solicited.

If the Examiner has any questions regarding this Amendment or the application in general, the Examiner is invited to contact the undersigned by phone at (650) 330-4908.

Respectfully submitted,

By:

  
Mark L. Warzel  
Registration No. 47,264

REED & EBERLE LLP  
800 Menlo Avenue, Suite 210  
Menlo Park, California 94025  
(650) 330-0900 Telephone  
(650) 330-0980 Facsimile